

REMARKS

Claims 1-27 are pending in this application, with claims 1, 10, 15, 16, and 23 being independent. Claims 23-27 have been amended. Favorable reconsideration and allowance are respectfully requested.

Claims 23-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory matter. Specifically, the Examiner has taken the position that these claims are directed to computer code *per se*, which the Examiner considers to be non-statutory. Applicant respectfully traverses this rejection, because it is believed that the computer code of the claimed invention “accomplish[es] a practical application” and therefore is statutory. M.P.E.P. § 2106(II)(A). The Federal Circuit has held, for example, that claims drawn to a long-distance telephone billing process were patentable, because “the claimed process applies to the Boolean principle to produce a useful, concrete, tangible result. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999) (see M.P.E.P. § 2106(II)(A)). In Applicant’s view, the results generated by the computer code of his claims is no less useful, concrete, or tangible than a long-distance telephone bill.

Nevertheless, in order to expedite prosecution, claims 23-27 have been amended to recite a “computer program product stored on a computer readable medium and executable on a network server.” Removal of the Section 101 rejection is respectfully requested.

Claims 1-6, 10-13, 15-18 and 22-27 were rejected under 35 U.S.C. § 103(a) as obvious from “USPS” (a collection of two articles, designated by the Examiner as U and W) in view of “WorldSpy” (a collection of three articles designated by the Examiner as UUU and U-V). Claims 7, 9 and 19-20 were rejected under 35 U.S.C. § 103(a) as obvious from “USPS” (a collection of four articles, designated by the Examiner as U-X) in view of “WorldSpy” (a collection of two articles designated by the Examiner as U-V, further in view of “PR Newswire” (an article designated by the Examiner as WW). Claims 8 and 21 were rejected under 35 U.S.C. § 103(a) as obvious from “USPS” (a collection of four articles, designated by the Examiner as U-X) in view of “WorldSpy” (a collection of three articles designated by the Examiner as U and U-V) further in view of “PR Newswire” (an article designated by the Examiner as WW) and further in view of Martin (an article designated by the Examiner as XX). Claim 14 was rejected under 35 U.S.C. § 103(a) as obvious from “USPS” (a collection of four articles, designated by the Examiner as U-X) in view of “WorldSpy” (a collection of three articles designated by the Examiner as UUU and U-V) and further in view of “Gralla” (an article designated by the Examiner as V). These rejections are respectfully traversed.

As recited in independent claim 1, the present invention relates to a computer on a network that effects the return of a consumer product for recycling. The computer is adapted to receive from another computer on the network consumer information, which includes an identification of the consumer product and also the present location of the consumer product. The computer automatically determines a destination for

the consumer product based upon the received identity of the product and its received present location, and automatically determines the carrier service that will deliver the product to the destination based upon the product's received present location and the location of the automatically determined destination. The computer further transmits to the other computer shipping label data, which includes an identification of the automatically determined destination and an identification of the automatically determined carrier service.

Independent claim 10 relates to a method for effecting consumer product returns for recycling over a network. Independent claim 15 relates to a computer operatively connected to a printer and located on a network. Independent claim 16 relates to a system for effecting the return of a consumer product. And independent claim 23 relates to computer code for effecting the return of a consumer product. All of those claims recite the salient features discussed above. Specifically, like claim 1 all of those claims recite:

- an AUTOMATICALLY DETERMINED DESTINATION, determined based on the RECEIVED identity of the consumer product and the RECEIVED present location of the consumer product; and
- an AUTOMATICALLY DETERMINED CARRIER SERVICE, determined based upon the RECEIVED present location of the consumer product, and the AUTOMATICALLY DETERMINED destination.

Neither of those features is taught or suggested by the prior art.

In rejecting the claims in view of WorldSpy and the other prior art, the Office Action focuses on the following portion of the UUU document, which describes the WorldSpy system as follows:

Here's how WorldSpy's system works: When customers choose to return goods, they fill out a return notice on WorldSpy's Web Site. WorldSpy then advises them where to send the items - either to a central warehouse managed by UPS Worldwide Logistics or directly back to the manufacturer - and credits customer's accounts when the items are received.

UUU at 3. The Office Action contends that this teaching, in conjunction with some other parts of the UUU, U and V documents, constitutes eliciting the consumer information required by the claims, automatically determining the destination or facility and automatically determining the carrier service. The Office Action concedes that WorldSpy does not teach transmitting shipping label data, but contends that that feature is taught by USPS, and concludes that the combination would have been obvious.

Applicant respectfully disagrees. All of the claims require the client providing consumer information that includes "an identification of the consumer product to be returned for recycling and an identification of the present location of the consumer product" (quoting claim 1). WorldSpy teaches a customer filling fill-out a return notice on a Web site, but provides no teaching as to what information the customer is required to provide. The Examiner appears to infer that the return notice would include present location information, but this inference is improper. Because the WorldSpy system does

not provide any shipping label data, but instead simply advises the customer where to send the items, there is no reason why present location information would be required, and thus no reason why it would be sought.

In addition, all of the claims require that the destination for the consumer product be automatically determined “based upon the received identity of the consumer product and the received present location of the consumer product” (quoting claim 1). WorldSpy does disclose choosing between one of two destinations: a central warehouse managed by UPS or directly back to the manufacturer. But it makes absolutely no mention of how the choice is made. Given that the reference does not even describe what type of information the customer provides, and in particular does not teach or suggest that present product location is provided, it certainly cannot be inferred that the choice is made on the basis of present product location.

All of the claims require that the carrier service be automatically determined “based upon the received present location of the consumer product and the location of the automatically determined destination” (quoting claim 1). There is no identification whatsoever in WorldSpy that a carrier service is automatically determined based on anything at, let alone on based on those two criteria. To the contrary, in WorldSpy, the Web site never determines the carrier service at all; it simply “advises [customers] where to send the items,” and leaves the customers to do the shipping on their own, using a carrier of the customer’s choosing.

Applicant notes that document U states that:

the management pact with UPSWL does not include a bias towards UPS delivery, he said. Instead, a purchase will trigger an electronic search within the WorldSpy computers for the best routing and cheapest price to achieve three-day deliver.

U at 6. The Examiner interprets this passage as teaching an automatically determined carrier service. Office Action at 22. Applicant disagrees with this interpretation. The passage refers to the forward logistics of delivering purchased products to customers, and not the reverse logistics of products being returned, and therefore cannot possibly teach or otherwise infer automatically determining a carrier service.

As to the other applied documents, USPS shows generating and transmitting shipping label data. Lewis teaches the inclusion of a pre-paid, postage-paid mailing label within the packaging of replacement cartridges. And Bisby teaches an 800-calling number that may be used for bulk returns. The Office Action does not contend that any of these documents teaches the features or the invention discussed above, and plainly they do not. Thus, none of those documents corrects the deficiencies of WorldSpy.

Accordingly, for at least the reasons above, Applicant respectfully submits that independent claims 1, 10, 15, 16 and 23 are clearly patentable over WorldSpy and the other applied documents, and respectfully requests the Examiner to remove the Section 103 rejections.

The remaining claims all depend from one of the independent claims discussed above, and each partakes in the novelty and non-obviousness of its respective

base claim. In addition, each recites additional patentable features of the present invention, and individual reconsideration of each is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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